

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

) Confirmation No.: 4330
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Applicants: MARGIOFF et al.) Group Art Unit: 2176
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Application No.: 10/766,964) Examiner: Orr, Henry W
)
Filing Date: January 29, 2004) APPEAL BRIEF
)
For: SYSTEMS AND METHODS FOR) Attorney Docket No.: E03.001U
PROVIDING AN IMPROVED)
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Sir:

Further to the Notice of Appeal filed March 11, 2009, Applicants hereby submit an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed September 12, 2008 (the “Final Office Action”) rejecting claims 1-4, 13-16, and 21.

REAL PARTY IN INTEREST

The present application is assigned to Innovation Interactive Inc., a corporation having a place of business at 28 West 23rd Street, 6th Floor, New York, NY 10010.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants, Appellants' legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-4, 13-16, and 21 are pending in this application.

Claims 5-12 and 17-20 have been canceled.

All pending claims stand rejected and are now being appealed.

STATUS OF AMENDMENTS

No after-final amendment has been filed in this application.

SUMMARY OF CLAIMED SUBJECT MATTER

Some embodiments of the present invention are associated with a set of buttons displayed on a search toolbar for a web browser. Specification, page 8, lines 6 to 10 and FIG. 3, element 320 (a financial toolbar including “financial info,” “trades,” “quotes,” and “news” buttons). A user may then provide a single indication. For example, the user might click on a “Get Travel TB” icon. Specification, page 8, lines 17 to 27 and FIG. 3, element 320. Responsive to the single indication, a subsequent set of toolbar buttons may be displayed to the user. Specification,

page 8, line 28 to page 9, line 7 and FIG. 3, element 330 (a travel toolbar including “travel info,” “tickets,” “hotels,” and “rentals” buttons).

* * * * *

Appellants will now map each of the independent claims, and any dependent claims that are argued separately, to the disclosure of this application.

* * * * *

Claim 1 (independent)

“initially displaying to a user a web page along with a web browser search bar, the web browser search bar including: (i) an initial set of toolbar buttons and (ii) a search feature user input portion usable to enter a search term to be transmitted to a remote search engine via a communication network, wherein the initial set of tool bar buttons is displayed to the user without displaying to the user a subsequent set of toolbar buttons in the searchbar.” — specification, page 8, lines 6 to 16 and FIG. 3.

“receiving a single indication from the user, the single indication being received via one of the initial set of toolbar buttons in the searchbar.” — specification, page 8, lines 17 to 27.

“responsive to said receiving of the single indication from the user, replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the searchbar such that (i) the initial and subsequent sets of toolbar buttons are not simultaneously displayed to the user in the searchbar and (ii) the search feature user input portion remains displayed to the user along with the subsequent set of toolbar buttons.” — specification, page 8, line 28 to page 9, line 15, page 10, lines 9 to 17, and element 330 of FIG. 3.

Claim 13 (independent)

“a processor.” — specification, page 10, lines 10 to 14.

“a storage device in communication with said processor and storing instructions adapted to be executed by the processor.” — specification, page 10, lines 19 to 28.

“initially display to a user in a web browser search bar: (i) an initial set of toolbar buttons and (ii) a search feature user input portion usable to enter a search term to be transmitted to a remote search engine via a communication network, wherein the initial set of tool bar buttons is displayed to the user without displaying to the user a subsequent set of toolbar buttons in the searchbar.” — specification, page 8, lines 6 to 16 and FIG. 3.

“receive a single indication from the user, the single indication being received via one of the initial set of toolbar buttons in the searchbar.” — specification, page 8, lines 17 to 27.

“replace the initial set of toolbar buttons with the subsequent set of toolbar buttons in the searchbar in response to the received indication, the result of the replacement being that (i) the initial and subsequent sets of toolbar buttons are not simultaneously displayed to the user in the searchbar and (ii) the search feature user input portion remains displayed to the user along with the subsequent set of toolbar buttons.” — specification, page 8, line 28 to page 9, line 15 and element 330 of FIG. 3.

Claim 21 (dependent)

“determine a query input from the user via the search feature user input portion.” — element 728 of FIG. 7.

“display a first search result to the user, the first search result being associated with the query input and further being received from a first remote search engine via the communication network.” — element 726 of FIG. 7.

“receive a first additional single indication from the user, the first additional single indication being received via a first toolbar button in the searchbar.” — element 724 of FIG. 7.

“responsive to said receiving of the first additional indication from the user, display a second search result to the user, the second search result being associated with the query input and further being received from a second remote search engine via the communication network”

“receive a second additional single indication from the user, the second additional single indication being received via the first toolbar button in the searchbar.” — specification, page 15, lines 23 to 28.

“responsive to said receiving of the second additional indication from the user, display a third search result to the user, the third search result being associated with the query input and

further being received from a third remote search engine via the communication network.” — specification, page 15, lines 29 to page 16, line 8.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 1-4 and 13-16 are rejected under 35 U.S.C. § 103 as being unpatentable over US Patent No. 7,222,303 (“Oren”) in view of US Publication No. 2007/0192725 (“Chen”).

(2) Claims 21 is rejected under 35 U.S.C. § 103 as being unpatentable over Oren in view of Chen and further in view of US Publication No. 2004/0061720 (“Weber”).

ARGUMENT

Claims 1-4 and 13-16 and Patentable

Claim 1 is directed to a method of facilitating use of a graphical user interface searchbar, and stands rejected under 35 U.S.C. § 103 as being unpatentable over US Patent No. 7,222,303 (“Oren”) in view of US Publication No. 2007/0192725 (“Chen”).

Claim 1 specifically recites “a search feature user input portion usable to enter a search term to be transmitted to a remote search engine via a communication network, wherein the initial set of tool bar buttons is displayed to the user without displaying to the user a subsequent set of toolbar buttons in the searchbar,” “receiving a single indication from the user, **the single indication being received via one of the initial set of toolbar buttons in the searchbar,**” and “responsive to ... receiving ... , replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the searchbar such that ... the search feature user input portion remains displayed to the user along with the subsequent set of toolbar buttons.” For example, a user might click on a button which is part of a set of financial toolbar buttons. A result, those buttons would be removed (including the button clicked on by the user).

Appellants gratefully acknowledge the statement in the Final Office Action that Oren does not teach or suggest such a feature. Final Office Action, page 4.

Appellants respectfully submit that Chen also does not disclose or suggest such a feature. At paragraph [0023], Chen merely states that a scroll left (or scroll right) control symbol on a toolbar can be used to shift toolbar buttons. Obviously, **the scroll control symbol itself would not be removed** as a result of being selected (such an approach would not make any sense).

Thus, even when taken in combination the references fail to disclose or suggest an element specifically recited in claim 1.

Moreover, in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d1596, 1598 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d1626, 1630 (Fed. Cir. 1996), although “the suggestion more often comes from the teachings of the pertinent references,” In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R.Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not evidence. Thus, when an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45,61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Oren discloses a toolbar with a search portion. Chen discloses a scroll-left or scroll-right control for a toolbar. According to the Final Office Action, it would have been obvious to add the scroll control of Chen to the system of Oren:

to provide the benefit of allowing a user to access toolbar buttons despite limited space on a display.

(Final Office Action, page 4). Applicants respectfully suggest that this falls far short of a motivation to combine these particular references in a way so as to produce the specific invention as recited in claim 1. That is, nothing in either reference teaches or suggests replacing an initial set of toolbar buttons, responsive to a single indication from the user via that initial set, without disturbing a search portion of the toolbar as recited of claim 1.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vacek, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

The absence of any motivation in the prior art (and the lack of a convincing line of reasoning) to modify the references so as to produce the invention specifically as recited in claim 1 indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction. The mere fact that embodiments of the present invention may provide benefits does not of course make the embodiments unpatentable.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established. The rejection of claim 1 should be reversed. The remaining claims depend from claim 1 (or contain similar limitations) and should therefore be allowable for at least the same reasons.

Claim 21 is Patentable

In the rejection of claim 21, the Examiner further combines the references discussed above with US Publication No. 2004/0061720 ("Weber"). In support of this combination, the Examiner asserts that such a combination is obvious:

to provide the benefit of accessing multiple online categorized search engine services and search the services directly from the browser.

Final Office Action, page 8. Appellants respectfully do not understand this reasoning. Nothing in Weber or any of the other references would lead one of ordinary skill in the art to produce a toolbar as specifically recited in these claims. Again, the Examiner has merely described the benefit of Applicants' invention. The improper combination of Weber with the other references is an additional reason why the rejection of claim 21 should be reversed.

CONCLUSION

The rejection of the claims herein is improper at least because of the reasons set forth herein. The Examiner's decision should therefore be reversed.

No fee is believed to be due. If any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-1852. An Appendix of claims involved in this appeal is attached hereto.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,

August 11, 2009

Date

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APPENDIX A—CLAIMS

1. A method of facilitating use of a graphical user interface searchbar, comprising:
initially displaying to a user a web page along with a web browser search bar, the web browser search bar including: (i) an initial set of toolbar buttons and (ii) a search feature user input portion usable to enter a search term to be transmitted to a remote search engine via a communication network, wherein the initial set of tool bar buttons is displayed to the user without displaying to the user a subsequent set of toolbar buttons in the searchbar;
receiving a single indication from the user, the single indication being received via one of the initial set of toolbar buttons in the searchbar; and
responsive to said receiving of the single indication from the user, replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the searchbar such that (i) the initial and subsequent sets of toolbar buttons are not simultaneously displayed to the user in the searchbar and (ii) the search feature user input portion remains displayed to the user along with the subsequent set of toolbar buttons.
2. The method of claim 1, further comprising:
displaying to the user additional sets of toolbar buttons in the searchbar in response to additional received indications.
3. The method of claim 1, wherein the initial set of toolbar buttons is replaced without changing the web page and further wherein each toolbar button within the initial set of toolbar buttons is related to a common class of functionality.
4. The method of claim 1, wherein each toolbar button within the subsequent set of toolbar buttons is related to a common class of functionality.

5-12. (Canceled)

13. An apparatus, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by the processor to:

initially display to a user in a web browser search bar: (i) an initial set of toolbar buttons and (ii) a search feature user input portion usable to enter a search term to be transmitted to a remote search engine via a communication network, wherein the initial set of toolbar buttons is displayed to the user without displaying to the user a subsequent set of toolbar buttons in the searchbar;

receive a single indication from the user, the single indication being received via one of the initial set of toolbar buttons in the searchbar; and

replace the initial set of toolbar buttons with the subsequent set of toolbar buttons in the searchbar in response to the received indication, the result of the replacement being that (i) the initial and subsequent sets of toolbar buttons are not simultaneously displayed to the user in the searchbar and (ii) the search feature user input portion remains displayed to the user along with the subsequent set of toolbar buttons.

14. The apparatus of claim 13, wherein the instructions are further adapted to be executed by the processor to:

display to the user additional sets of toolbar buttons in the searchbar in response to additional received indications.

15. The apparatus of claim 13, wherein each toolbar button within the initial set of toolbar buttons is related to a common class of functionality.

16. The apparatus of claim 13, wherein each toolbar button within the subsequent set of toolbar buttons is related to a common class of functionality.

17-20. (Canceled)

21. The apparatus of claim 13, wherein the instructions are further adapted to be executed by the processor to:

determine a query input from the user via the search feature user input portion;

display a first search result to the user, the first search result being associated with the query input and further being received from a first remote search engine via the communication network;

receive a first additional single indication from the user, the first additional single indication being received via a first toolbar button in the searchbar;

responsive to said receiving of the first additional indication from the user, display a second search result to the user, the second search result being associated with the query input and further being received from a second remote search engine via the communication network;

receive a second additional single indication from the user, the second additional single indication being received via the first toolbar button in the searchbar; and

responsive to said receiving of the second additional indication from the user, display a third search result to the user, the third search result being associated with the query input and further being received from a third remote search engine via the communication network.

APPENDIX B - EVIDENCE

No evidence is being submitted with this Appeal Brief (*i.e.*, this appendix is empty).

APPENDIX C - RELATED PROCEEDINGS

No prior or pending appeals, interferences, or judicial proceedings are known to Applicants, Applicants' legal representative, or assignee, which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. Therefore, there are no copies of decisions rendered by a court or the Board to attach (*i.e.*, this appendix is empty).